

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-9 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, the amendment to claim 1 is supported by the Specification at page 20, lines 10-18. Accordingly, no new matter has been added.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statement (IDS) submitted on March 22, 2007. Applicants note, however, that the Examiner has crossed out one reference (WO 99/22684) from the IDS.

Accordingly, Applicants respectfully request that the Examiner considers and makes of record the crossed-out reference cited on the IDS submitted on March 22, 2007.

Issues Under 35 U.S.C. § 102(b)

Claims 1 and 3-4 stand rejected under 35 U.S.C. §102 (b) as being anticipated by Ducker et al. (U.S. 5,938,649) (hereinafter Ducker '649). Applicants respectfully traverse.

The Examiner asserts that Ducker '649 discloses a diaper comprising a liquid impermeable back outer layer sheet, an absorber fixed on the outer layer sheet and a gather portion having a flexible elastic member formed on a predetermined position. The Examiner further asserts that Ducker '648 teaches the application of a water-soluble skin care agent on a

surface to be contacted with the skin of the wearer and an oily skin care agent "applied directly on the water-soluble skin care agent".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. §102, the reference must teach each and every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present". *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The present invention is directed, *inter alia*, to an absorbent article wherein a water-soluble skin care agent and an oily skin care agent are applied on a surface of the article. In the absorbent article of the present invention, the oily skin care agent is applied on a predetermined region of a sheet of absorbent article on which a water-soluble skin care agent is applied. Further, the oily skin care agent is applied directly on the water-soluble skin care agent (without the need for auxiliary agents), so that at least a portion of the oily skin care agent is transferred to the skin of the wearer before the water-soluble skin care agent is transferred. By allowing a portion of the oily skin care agent to transfer to the skin of the wearer before the water-soluble skin care agent is transferred, the absorbent article of the present invention unexpectedly provides a superior skin care effect, not only before micturition or urination, but also after micturition.

Contrary to the Examiner's assertion, Ducker '649 fails to implicitly or explicitly teach an absorbent article as presently claimed, wherein an oily skin care agent is applied directly on the water-soluble skin care agent, such that at least a part of the oily skin care agent is able to be transferred to the skin of a wearer before the water-soluble skin care agent transferred thereto. For instance, Ducker '649 discloses at column 5, lines 30-42, that the aloe vera is "incorporated" into a "relatively waterless solution" and that "preferably, the other constituent of the solution is a lubricant. Most preferred, the lubricant is petrolatum". Thus, Ducker '649 does not teach applying the oily skin care agent directly on (emphasis added) the water-soluble skin care agent. Furthermore, based on Ducker's disclosure, it is impossible to determine whether "at least a part of the oily skin care agent is able to be transferred to the skin of a wearer when worn before the water-soluble skin care agent is able to be transferred to the skin of the wearer", as presently claimed.

Applicants have conducted experimental tests to compare the presently claimed article and the article of Ducker '649. As evidenced by the results of these tests (see Table 1 below), the presently claimed absorbent article achieves unexpected and superior results over the article of Ducker '649. For instance, the absorbent article of Ducker '649 does not exhibit any effect on diaper rash. In stark contrast, the use of the absorbent article of the present invention results in a significant decrease in diaper rash.

Table 1

		Example 1 (article of the present invention)	Comparative Example 1 (corresponding to Ducker '649)
Water-soluble skin care agent		Hamamelis extract 1%	Hiba extract 1%
Oily skin care agent		Diamide derivative	Wax, ester oil and petrolatum
Auxiliary agent		None; unnecessary	Surfactant; necessary to mix water with oil
Method of applying skin care agent		The diamide derivative was applied on a predetermined region of a sheet or absorbent article to be contacted with the skin of a wearer, on which the Hamamelis extract was applied	Hiba extract, wax, ester oil, petrolatum and surfactant were mixed, and then the mixture was applied on the surface of the diaper to be contacted with the skin of a wearer
Application amount of skin care agent		10g/m ² in total	10g/m ² in total
Incidence of diaper rash	Diapers with no skin care agents	Average incidence: 30 times/14 subjects/two weeks (i.e., the number of times of incidence of diaper rash was 30, including re-incidence) =1.1 times/subject/week.	In one out of five people, the rash was observed. Average incidence: 1time/5 subjects/16days= 0.4 times/subject/week
	Diapers with skin care agents	Average incidence: 13 times/14 subjects/two weeks =0.4 times/subject/week.	In four out of five people, the rash was observed. Average incidence: 9times/5 subjects/32days= 2 times/subject/week
Number of diapers used when the rash was observed	Diapers with no skin care agents	278 out of 1167 diapers	1 out of 69 diapers
	Diapers with skin care agents	131 out of 1290 diapers	61 out of 142 diapers

Clearly, the incidence of diaper rash was reduced by more than half when utilizing the novel absorbent article of the present invention.

Applicants submit that Ducker '649 fails to explicitly or implicitly teach each and every aspect of the claimed invention and thus fails to anticipate the same.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

Issues Under 35 U.S.C. § 103(a)

Claim 2 stands rejected under 35 U.S.C. §103(a) as being obvious over Ducker '649. Additionally, claims 5-9 stand rejected under 35 U.S.C. §103(a) as being obvious over Ducker '649 in view of Hoshino et al. (U.S. 6,685,953) (hereinafter Hoshino '953) further in view of Ptchelintsev et al. (U.S. 5,834,513) (hereinafter Ptchelintsev '513). Applicants respectfully traverse.

The Examiner asserts that the difference between Ducker '649 and the present invention is "the provision that the diamide formula is specifically as claimed". The Examiner relies on Hoshino '953 and Ptchelintsev '513 to overcome this deficiency.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *Id.* There must be a reason that would have prompted a

person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

As discussed above, Ducker '649 fails to teach an absorbent article comprising an impermeable back sheet/outer layer and a permeable top sheet covering an absorbent core and forming a barrier cuff, wherein an oily skin care agent is applied on a predetermined region of a sheet or absorbent article on which a water-soluble skin care agent is applied, and wherein the oily skin care agent is applied directly on the water-soluble skin care agent, such that it is transferred to the skin of the wearer before the water-soluble skin care agent is transferred. Hoshino '953 and Ptchelintsev '513 fail to cure these deficiencies.

Hoshino '953 is directed to external preparation compositions comprising a diamide derivative. Hoshino '953 does not disclose the addition of this derivative to absorbent articles, or the combination of this composition with a water-soluble skin care agent.

Ptchelintsev '513 is directed to compounds used for treating skin conditions. Ptchelintsev '513 does not disclose the addition of these compounds to absorbent articles, or the combination of these compounds with a water-soluble skin care agent.

Evidently, the cited references, alone or in combination, fail to teach or suggest every limitation of the instant invention. Accordingly, this rejection is improper.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

Miscellaneous

Applicants respectfully request that the Examiner acknowledges Applicants' claim for foreign priority under 35 U.S.C. § 119.

Conclusion

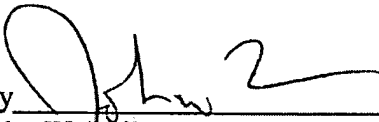
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey, Reg. No. 32,881 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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